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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/526,177	03/15/2000	Takashi Munakata	44084-443	9237
20277	7590	06/16/2004	EXAMINER	
MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			TRAN, DOUGLAS Q	
			ART UNIT	PAPER NUMBER
			2624	9
DATE MAILED: 06/16/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/526,177

Applicant(s)

MUNAKATA ET AL.

Examiner

Douglas Q. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7, 8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 10 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restriction*

1. Amended claim 10 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

This application contains claims directed to the following patentably distinct species of the claimed invention:

Group I: Amended claims 7-8 read on Figs. 1-2 ( Applicant's first embodiment);

Group II: Amended claim 10 read on Figs 3-6 ( Applicant's second embodiment).

2. This application contains claims directed to the following patentably distinct **species** of the claimed invention: Group I discloses only one image forming apparatus (i.e., a network printer 1 in fig. 1) comprising a controller for controlling a plurality of notifying units respectively disposed on the paper ejection trays or in the vicinity of the paper ejection trays, and notifying a user of a specific one of the paper ejection trays in which a last ejected sheet is present. Group II discloses a plurality of printers (1a and 1b) which is controlled to continuously distribute the remaining sheets to available trays of another of one of the plurality of image forming units.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

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Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 10 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Mandel et al. (US Patent No. 5,823,529) (or Mandel '529') and Mandel et al. (US Patent No. 5,358,238) (or Mandel '238').

As to claim 7, Mandel '529' discloses an image forming apparatus (i.e., electronic printer 14 in fig. 6) capable of being connected to a plurality of external apparatuses (15 in fig. 6) and performing image formations based on data sent from the external apparatuses (col. 31, lines 30-33 describes that trays for receiving recording sheets on which images are formed "discharged" from inside of the printer; the sheets at these trays are already printed with images from the print jobs "col. 2, lines 34-37"), said image forming apparatus comprising:

a plurality of paper ejection trays (figure 5 shows the printer having a mailbox system includes the mailbox bins or trays 11, 116, 23 in fig. 5, col. 12, lines 46-49) for receiving sheets on which images are formed (col. 31, lines 30-33 describes that trays for receiving recording sheets on which images are formed "discharged"); and

notification means (i.e., a controller 100 in fig. 5) for notifying a user of a specific one of the paper ejection trays in which a last ejected sheet is present (col. 29, lines 22-34: the user send the print job to the "almost-full" bin of the printer, the print job is separated into two parts, the first part is delivered to the "almost-full" bin until the bin is full, then the rest of that print job is delivered onto newly assigned bin 11. It is noted that the rest of that print job would be at least one of the last sheets. The user is informed of that automatically through a message "col. 29, lines 33-34". Therefore, the user would be notified his print job locates on two different bins

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including the last assigned bin storing the last part of the print job. The printer inherently comprises a component corresponding to notification means for generating a message to the user of the status of his print job stored in the specified trays, or the notification means would be a controller "100 in the mailbox system in fig. 5" because there only is a controller in this mailbox system for generating a display instructional signal to the terminal 15 of the assigned user "col. 29, lines 4-9". Thus, the controller 100 would also notify the status of the assigned user's print job at the printer trays).

a controller (100 in fig. 5), connected with the notifying unit (104 in fig. 5), for controlling the notifying unit including controlling a respective notification unit to communicate an indication notifying the user that the last ejected sheet is present in the corresponding paper ejection (col. 29, lines 22-34: the user send the print job to the "almost-full" bin of the printer, the print job is separated into two parts, the first part is delivered to the "almost-full" bin until the bin is full, then the rest of that print job is delivered onto newly assigned bin 11. It is noted that the rest of that print job would be at least one of the last sheets on the newly assigned bin 11. The user is informed of that automatically through a message "col. 29, lines 33-34". Therefore, the user would be notified his print job locates on two different bins including the last assigned bin storing the last part of the print job or the last sheet).

Although Mandel '529' teaches notification means (i.e., a controller 100 in fig. 5) for notifying a user of a specific one of the paper ejection trays in which a last ejected sheet is present, Mandel does not teaches a plurality of notifying units disposed on the paper ejection trays or in the vicinity of the paper ejection trays.

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Mandel '238' teaches a plurality of notifying units disposed on the trays that is controlled by the controller (100 in fig. 14) (please see fig. 18 indicates each bin has an associated LCD, col. 27, lines 57-63 and col. 3, lines 11-15 and col. 5, lines 37-43) (it is noted that since there are a plurality of notifying units disposed on the trays, the notifying units are controlled in which each unit indicates at least the printing sheet of the print job. Thus, the user is notified that the last ejected sheet is present in the corresponding paper ejection tray by one of LCDs).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the notifying means of Mandel '529' includes a plurality of notice units respectively corresponding to the bins as taught by Mandel '238'. The suggestion for modifying the notifying means of Mandel '529' can be reasoned by one of ordinary skill in the art as set forth above by Mandel '238' because the modified printing system would increase to be flexible and capability to have a different kind of notifying means for notifying the status of the completely print jobs to the user.

As to claim 8, Mandel '529' and '238' teaches every feature in claim 7, and Mandel '238' further teaches the controller controls a plurality of display units, that is corresponding to the plurality of paper ejection trays receiving the sheets ejected in response to at least one ejection instruction from the same external apparatus, to display same display content to (please see fig. 18 indicates each bin has an associated LCD, col. 27, lines 57-63 and col. 3, lines 11-15 and col. 5, lines 37-43).

***Response to Arguments and Amendment***

Applicant's arguments filed 4/7/04 with respect to claims 7-8 and 10 have been fully considered but they are not persuasive.

Applicant asserted in page 7 that "amended claim 10 includes features of the second embodiment where, when there are a plurality of network connected printers and a plurality of PCs connected to the plurality of printers, when a necessary number of paper ejection trays for ejecting the number of sheets specified by the PCs connected to one printer are not left in the printer, the overflowing sheets are output into the paper ejection trays of another printer". In reply, because of the limitations of the claim 10 are amended to include features of the second embodiment, claim 10 is classified for restriction.

Applicant asserted in page 6 that "the controller 100 cannot reasonably be interpreted as controlling a notification unit that is disposed on the paper ejection trays or in the vicinity of the paper ejection trays to communicate an indication notifying the user that the last ejected sheet is present in the corresponding paper ejection tray, as occurs in the present invention" In reply, Mandel (US Patent No. 5,358,238) discloses a bin assignment scheme wherein each bin has an associated LCD or other type of display with the appropriate user name or label displayed, and/or a common or central display, as in the example herein, and/or wherein are placed in more than one available bin if needed (col.3, lines 10-16). Therefore, Mandel teaches the well known in the prior art of the controller for connecting with each of LCDs (or other type of display) of each associated bin and for controlling the each of LCDs to communicate an indication notifying the user (i.e., user name or label displayed) that jobs are placed each of bins. Thus, Mandel (238)



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would modified to the deficiency of Mandel (529) in which each of LCDs indicating parts of print job to the user including the indication of a last sheet to a last bin.

For the above reasons, it is believed that the cited prior art fully discloses the claimed invention and the rejection stand.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or E-mail address is Douglas.tran@uspto.gov.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran  
June 08, 2004

  
GABRIEL GARCIA  
PRIMARY EXAMINER